

REMARKS

The Examiner is thanked for the thorough examination of this application. The Office Action, mailed February 24, 2005, however, rejected all claims 1-16. Specifically, the Office Action rejected claims 1-3 under 35 U.S.C. 102(b) as allegedly unpatentable over Muller (US 3,832,669). Further, the Office Action has rejected claims 1-6, 8-11 under 35 U.S.C. 103(a) as allegedly unpatentable over Lu (US 6,676,290) in view of Mueller (US 3,832,669). The Office Action has rejected claims 12-15 under 35 U.S.C. 103(a) as allegedly unpatentable over Lu (US 6,676,290) in view of Zaragoza (US 5,133,606). The Office Action has rejected claim 16 under 35 U.S.C. 103(a) as allegedly unpatentable over Lu (US 6,676,290) in view of Hsieh (US 6,854,880) and Mueller (US 3,832,669). Furthermore, the Office Action has rejected claim 7 under 35 U.S.C. 103(a) as allegedly unpatentable over Lu (US 6,676,290) in view of Martin (US 4,603,026).

Claims 1-16 have been cancelled and claims 17-21 are newly added. As claims 1-16 have been cancelled, the outstanding rejections are moot.

With regard to the newly added claims, independent claim 17 recites:

17. A temperature probe comprising:
a probe body;
a hollow tip member secured to the probe body, wherein the hollow tip member comprises:
an outer wall as a thermal contact surface,
an inner wall inside the outer wall,
a thermal isolation space formed between the outer wall and the inner wall, and
a hollow cavity surrounded by the inner wall;
a thermal sensor disposed within the hollow tip member for sensing the temperature of the thermal contact surface and producing a temperature signal;
and
a set of transmission wires connected to the thermal sensor for passing the temperature signal;
wherein the inner wall comprises a hole near the rear end of the hollow tip member for allowing the transmission wires to be passed into the hollow cavity.

(Emphasis Added)

Specifically, the limitation in claim 17 ” **wherein the inner wall comprises a hole near the rear end of the hollow tip member for allowing the transmission wires to be passed into the hollow cavity**” is newly added and clearly defines this claim over the cited art of record. Support for this limitation can be found on at least page 10, lines 3-6 and FIG. 3. Accordingly, Applicant submits that no new matter has been added by virtue of this amendment, and it is respectfully that these claims be passed to issuance.

Applicant respectfully asserts that the cited references are deficient for the purpose of rendering claim 17 unpatentable. Specifically, Applicant respectfully asserts that the references do not teach or reasonably suggest at least the features/limitation emphasized above in claim 17.

Insofar as claims 18-21 depend from new claim 17, it is Applicant’s believe that these claims are also allowable at least by virtue of their dependency.

Legally Deficient Rejections Under 35 U.S.C. § 103

Although the claim rejections have been rendered moot by the cancellation of claims 1-16 and the addition of new claims, Applicant wishes to briefly address the rejections that were made under 35 U.S.C. § 103(a) (see e.g., rejections to claims 1-6, 8-11, 12-15, 7, and 16 in paragraphs 4, 5 , 6, and 7, respectively, of the Office Action). The Office Action has failed to provide or cite proper motivations or suggestions to combine the references.

In this regard, to reject claims in an application under 35 U.S.C. § 103, an Office Action must show an un rebutted prima facie case of obviousness. *In re Rouffet* 149 F.3d 1350 at 1355 (Fed. Cir. 1998) (citing *In re Deuel*, 51 F.3d 1552, 1557, 34 U.S.P.Q.2d 1210, 1214

(Fed.Cir.1995). In the absence of a proper prima facie case of obviousness, an applicant is entitled to a patent. See In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed.Cir.1992).

Applicant respectfully submits that the Office Action has failed to set forth a legally complete and proper rejection under 35 U.S.C. § 103(a). Accordingly, the rejection should be withdrawn as a matter of law.

It is well-settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc., 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(Emphasis added) In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, Applicant notes that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. Stiftung v. Renishaw PLC, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements to realize a temperature probe, as claimed by the Applicant.

When an obviousness determination is based on multiple prior art references, there must be a showing of some “teaching, suggestion, or reason” to combine the references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the “absence of such a suggestion to combine is dispositive in an obviousness determination”).

Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be “clear and particular.” Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617.

If there was no motivation or suggestion to combine selective teachings from multiple prior art references, one of ordinary skill in the art would not have viewed the present invention as obvious. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); Gambro Lundia AB, 110 F.3d at 1579, 42 USPQ2d at 1383 (“The absence of such a suggestion to combine is dispositive in an obviousness determination.”).

Significantly, where there is not apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. Winner Int’l Royalty Corp. v. Wang, No 98-1553 (Fed. Cir. January 27, 2000).


Again, the rejections of these claims are moot. The foregoing has been set forth in the event that an ensuing Office Action makes similar rejections to claims 17-21.

CONCLUSION

In view of the foregoing, it is believed that all pending claims are in proper condition for allowance. If the Examiner believes that a telephone conference would expedite the examination of the above-identified patent application, the Examiner is invited to call the undersigned.

No fee is believed to be due in connection with this amendment and response to Office Action. If, however, any fee is believed to be due, you are hereby authorized to charge any such fee to deposit account No. 20-0778.

Respectfully submitted,

By: 
Daniel R. McClure
Registration No. 38,962

Thomas, Kayden, Horstemeyer & Risley, LLP
100 Galleria Pkwy, NW
Suite 1750
Atlanta, GA 30339
770-933-9500